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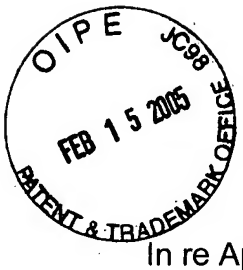


PATENT
Customer No. 22,852
Attorney Docket No. 09095.0009-01000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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|---|---|
| In re Application of: | |
| Wang et al. | Group Art Unit: 1614 |
| Application No.: 10/773,332 | Examiner: K. Habte |
| Filed: February 9, 2004 | |
| For: ARYL PHENYLHETEROCYCLYL SULFIDE DERIVATIVES AND THEIR USE AS CELL ADHESION-INHIBITING ANTI-INFLAMMATORY AND IMMUNE-SUPPRESSIVE AGENTS | Confirmation No.: 8910 |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

## RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated February 1, 2005, the Examiner required restriction under 35 U.S.C. § 121 between:

> **Group I**: Claims 1-25, "drawn to formula I compounds, where $R^1$ or $R^3$ in the chemical structure is pyridinyl, classified for example in class 546, subclass 258 and 268.1," and
>
> **Group II**: Claims 26-27, "drawn to a method of ameliorating a pathology in a mammal selected from inflammatory diseases, an autoimmune disease, tumor metastasis, allograft rejection and reperfusion injury, classified in class 514, subclass various."

Applicants elect, with traverse, the subject matter of Group I (claims 1-25), drawn to "formula I compounds, where $R^1$ or $R^3$ in the chemical structure is pyridinyl."

The Examiner alleges that the inventions of Groups I and II are related as a product and a process of use and contends that the inventions are distinct. *Office Action* at p. 2. According to the Examiner, the pyridinyl compounds of Group I can allegedly be used for "treating pain that is a materially different process" from the process of Group II. *Id.* In addition, the Examiner believes that the inventions of Groups I and II have "acquired a separate status in the art" as evidenced by their different search classifications. *Id.* at p. 3.

Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P instructs the Examiner as follows:

> If the search and examination of an entire application can be made **without serious burden**, the Office **must** examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I and II together would constitute a serious burden. All of the claims recite a compound of Formula I. Thus, a search of Group II will substantially, if not completely, overlap with the search for Group I.

Furthermore, the United States Patent and Trademark Office has already demonstrated that searching all of claims 1-27 is not a serious burden. During prosecution of the parent U.S. Application No. 09/888,840 ("the parent application"), which issued as U.S. Patent No. 6,787,542 B2 ("the '542 patent"), the Examiner issued a restriction requirement, in which the pending claims 1-27 were restricted into Groups I-V. (*See Office Action* in U.S. Serial No. 09/888,840 dated September 13, 2002, at pp.

2-3.) Pending claims 1-27 of the parent application recited similar limitations as the currently pending claims but were drawn to a genus of heterocyclic compounds. Applicants elected Group I, drawn to pyrimidinyl compounds, and the Examiner did not require a further restriction of claims 26 and 27. The Examiner's search and examination of elected Group I, both product and process claims, culminated in the issuance of the '542 patent.

Applicants respectfully indicate that claims 1-27 of the present application are directed to Group II of the parent application's restriction requirement, a group of claims already identified by the Examiner as proper for search and examination. *Id.* Applicants note that the Examiner identified a single search classification for the parent Group II as "class 546, subclass various." *Id.* Yet now, the Examiner asserts that restriction is warranted by citing different classifications for present Groups I and II. Applicants respectfully maintain that in view of the fact that the restriction requirement in the parent application deemed the scope of the search on currently pending claims 1-27 proper and not overly burdensome, a search of that same scope in this application cannot impose a serious burden on the Examiner. Accordingly, Applicants respectfully request withdrawal of this restriction requirement.

In the event the Examiner upholds the restriction requirement, Applicants respectfully request the Examiner to rejoin the process claims of Group II upon the indication of allowable subject matter in the product claims of Group I. In accordance with the rejoinder procedure set out in M.P.E.P. §821.04, which establishes guidelines for treating restriction between product and process claims in light of *In re Ochiai*, 71 F.3d 1565, 37 USPQ 2d 1127 (Fed. Cir. 1995), if the claims directed to a product are

found allowable, the withdrawn process claims, which include all the limitations of the product claims, should be rejoined.

## III. Conclusion

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P

Dated: February 15, 2005

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